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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,883	03/08/2001	Gerbrand Deetman	12598.0131CNUS00	7184

27128 7590 09/14/2004

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EXAMINER

OGDEN JR, NECHOLUS

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action in Ex Parte Reexamination	Control No. 09/801,883	Patent Under Reexamination DEETMAN, GERBRA	
	Examiner Necholus Ogden	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a ☒ Responsive to the communication(s) filed on 14 November 2003. b ☐ This action is made FINAL.
 c ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 3 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input type="checkbox"/> Information Disclosure Statement, PTO-1449. | 4. <input type="checkbox"/> _____. |

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 90-106 are subject to reexamination.
 1b. ☐ Claims _____ are not subject to reexamination.
 2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
 3. ☐ Claims _____ are patentable and/or confirmed.
 4. ☒ Claims 90-106 are rejected.
 5. ☐ Claims _____ are objected to.
 6. ☐ The drawings, filed on _____ are acceptable.
 7. ☐ The proposed drawing correction, filed on _____ has been (7a) ☐ approved (7b) ☐ disapproved.
 8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
 1 ☐ been received.
 2 ☐ not been received.
 3 ☐ been filed in Application No. _____.
 4 ☐ been filed in reexamination Control No. _____.
 5 ☐ been received by the International Bureau in PCT application No. _____.
 * See the attached detailed Office action for a list of the certified copies not received.
 9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
 10. ☐ Other: _____

cc: Requester (if third party requester)

Reissue Applications

1. The original patent---37 CFR 1.178.

Applicant has surrendered the original patent (5,464,551) in conjunction with the allowance and issuance of the parent reissue application no. 08/966,425.

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 90-106 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. Claims 90-106 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows

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that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the filing of the present reissue application cannot recapture the patent.

4. Applicant argues, in summary, that they "...mistakenly chose to amend the claims to recite this limitation."

The examiner contends that a claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. The courts have held that said reissue claims are invalid on grounds of improper recapture of the subject matter surrendered during prosecution to avoid prior art rejections. Since Reissue claims eliminated the substantially C4 or C5 isoalkyl base stock material limitations, and thus is broader than the corresponding claim of the original patent, and this broadened aspect of the claim relates to surrendered subject matter during prosecution of original application. Moreover, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution the flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." Accordingly, applicant is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections. *Pannu v. Storz Instruments Inc.*, 59

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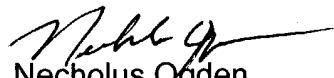
USPQ2d 1597; Anderson v. Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also Mentor, 998 F.2d at 996, 27 USPQ2d at 1525.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 703-308-3732. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 703-308-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Necholus Ogden
Primary Examiner
Art Unit 1751

No
June 17, 2004